

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT:	PECEN, Mark. et al.	EXAMINER:	Wendell, A.
SERIAL NO.:	10/804,292	GROUP:	2618
FILED:	March 19, 2004	CASE NO.:	CS24583RL
ENTITLED:	APPARATUS AND METHOD FOR HANDOVER BETWEEN TWO NETWORKS DURING AN ONGOING COMMUNICATION		

Motorola, Inc.
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Commissioner:

Further to the Notice of Appeal filed concurrently herewith, Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request. The review is requested for the reasons stated in the remarks below.

REMARKS

Claims 1, 3-10, 12-18, 20-27, and 29-34 are pending in this application.

The Office Action rejects, under 35 U.S.C. § 102, claims 1-4, 7-8, 18-20, and 24-25 over Shaheen et al. (U.S. Patent Pub. No. 2004/0203792). The Office Action also rejects, under 35 U.S.C. § 103, claims 5-6 and 22-23 over Shaheen et al. and Boyer et al. (U.S. Patent No. 7,050,812), claims 9 and 26 over Shaheen et al. and Stumpert et al. (U.S. Patent Pub. No. 2004/0157600), claims 10, 11, 16, 17, 21, 27, 33, and 34 over Shaheen et al. and Ovesjo et al. (U.S. Patent Pub. No. 2002/0160785), claims 12, 14, 29, and 30 over Shaheen et al., Ovesjo et al., and Boyer et al., and claims 13, 15, 31, and 32 over Shaheen et al., Ovesjo et al., and Yahagi (U.S. patent No. 7,065,360). These rejections are respectfully traversed.

Applicants maintain that Shaheen et al. does not disclose or suggest detecting a presence of a wireless local area network, the wireless local area network being unregistered with the cellular radio access network at initial detection of the presence of the wireless local area network while in the ongoing communication and transferring the ongoing communication from the cellular radio access network to the wireless local area network, as recited in independent claim 1 and similarly recited in independent claim 18.

The feature of one network being unregistered with another network is simply not present in Shaheen et al. (*see* March 28, 2007 Request for Reconsideration, page 12, first full paragraph)

Because the feature is not present in Shaheen et al, consequently the Office Actions were unable to cite any location of Shaheen et al. teaching wireless local area network being unregistered with the cellular radio access network at initial detection of the presence of the wireless local area network.

In fact, Applicants expressly pointed out how Shaheen et al. discloses the opposite of the claimed feature (*supra*, bottom of page 9 through first paragraph of page 10).

Furthermore, the failure of the Office Action to provide a reference that teaches the claimed element is illustrated by the Advisory Action when it appeared to admit that the Office Actions have not properly complied with the requirements of a rejection under 35 USC § 102. In particular, the Advisory Action alleged "Applicant has failed to point out where in Shaheen that

it teaches the local area network is specifically registered with the UMTS network." In response, Applicants would like to point out that, according to 35 USC § 102, the reference must describe all of the claimed features. The response of the Advisory Action only merely avoids the fact that Shaheen et al. does not disclose the claimed feature. Thus, the Office Actions have not properly complied with the requirements of a rejection under 35 USC § 102.

Applicants further assert that Shaheen et al. and Ovesjo et al do not disclose or suggest receiving a measurement report including a fictitious neighbor value, as recited in independent claim 10 and similarly recited in independent claim 27 (*supra*, page 13, first two full paragraphs).

In response to Applicants assertions that the references do not disclose a fictitious neighbor value, the Office Action could only allege, "Any measurement done can be fictitious." This supports the fact that the references do not disclose the claimed feature because the Office Action could only reply with an allegation that is not present in the references. Furthermore, Applicants provided numerous reasons why the feature is simply not present in the references (*supra*, bottom half of page 10).

Applicants appreciate the Advisory Action's suggestion of, "Examiner welcomes the applicant to amend the claims to further define a fictitious value (defining it to mean made up or fictional)." However, Applicants maintain that the cited references do not disclose a fictitious neighbor value, as recited in independent claim 10 and similarly recited in independent claim 27.

Therefore, Applicants respectfully submit that independent claims 1, 10, 18, and 27 define patentable subject matter. The remaining claims depend from the independent claims and therefore also define patentable subject matter. Accordingly, Applicants respectfully request the withdrawal of the rejections under 35 U.S.C. § 102 and 35 U.S.C. § 103.

CONCLUSION

Based on the foregoing amendments and remarks, Applicants respectfully submit this application is in condition for allowance.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

The Commissioner is hereby authorized to deduct any fees arising as a result of this Amendment or any other communication from or to credit any overpayments to Deposit Account No. 50-2117.

Respectfully submitted,

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